

16 MAR 2007

#17



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Charles A. Muserlian
Hedman and Costigan
1185 Avenue of the Americas
New York, NY 10036

In re Application of	:	
TRIFONI, et al.	:	DECISION ON PETITION
Serial No.: 10/517,982	:	
PCT No.: PCT/EP03/06327	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 16 June 2003	:	
Priority Date: 17 June 2002	:	
Atty Docket No.: 267.184	:	
For: MEMBRANE ELECTROCHEMICAL	:	
GENERATOR	:	

This decision is issued in response to applicant's (second) "Renewed Petition Under Rule 37 CFR 1.47(a)" filed 31 January 2007 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon. Additionally, this decision is issued in response to applicant's "Petition under 37 CFR 1.182" filed 08 March 2007.

BACKGROUND

On 16 June 2003, applicant filed international application PCT/EP03/06327 which claimed priority to a previous application filed 17 June 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 17 December 2004.

On 13 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an Information Disclosure Statement. In addition, applicant filed a declaration and power of attorney executed by seven of the nine inventors listed on the published international application.

On 09 June 2005, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon.

On 13 July 2005, applicant was mailed a "Notification of Missing Requirements under 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing

date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

In a Decision dated 23 February 2006, applicant's petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 10 May 2006, applicant filed a renewed petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon. In a Decision dated 29 August 2006, applicant's petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 31 January 2007, applicant filed a second renewed petition under 37 CFR 1.47(a).

On 08 March 2007, applicant filed a "Petition under 37 CFR 1.182."

DISCUSSION

A. Petition under 37 CFR 1.181

Applicant states in their present petition that a renewed petition under 37 CFR 1.47(a) was received by the USPTO on 17 October 2006. A review of the application file reveals that the renewed petition under 37 CFR 1.47(a) is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "Return Postcard" states, in part:

"A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Here, applicants have provided a copy of their date-stamped filing receipt. The receipt identifies the application by the title of invention; applicant's name; and docket number. The evidence submitted by applicants, consisting of a postcard receipt with a PCT/PTO mailroom date stamp of 17 October 2006 which itemizes all the papers filed on said date. The postcard receipt bearing the applicant's name, title of invention, and attorney docket number is sufficient to indicate that the above papers were received on 17 October 2006.

B. Renewed Petition under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

A review of the papers filed 31 January 2007 reveals that petitioner has paid the requisite petition fee, provided sufficient proof that the non-signing inventor (Eduardo Trifoni and Matteo Lenardon) refused to sign, stated the last known address of the non-signing inventor (Eduardo Trifoni and Matteo Lenardon), and provided an acceptable declaration. Accordingly, all of the requirements of items (1), (2), (3), and (4) above have been satisfied.

C. Petition under 37 CFR 1.182.

Applicant states in the present petition that Antonino Toro (not Toro Antonino as listed on the published international application) is the correct name of the eighth inventor. As indicated in Section 201.03 of the Manual of Patent Examining Procedure, where a typographical or transliteration error in the spelling of an inventor's name is discovered, a petition under 37 CFR 1.48(a) is not required. In that this is clearly more than a mere typographical error or a phonetic misspelling of applicant's given name on the published international application, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Accordingly, applicant's explanation of the difference in the spelling of the eighth inventor's name is accepted and noted for the record. The petition under 37 CFR 1.182 is granted and the declaration submitted on 13 December 2004 is accepted.

CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is GRANTED.

Applicant's petition under 37 CFR 1.181 and 37 CFR 1.182 are GRANTED.

The application has an international filing date of 16 June 2003 under 35 U.S.C. 363, and will be given a date of 13 December 2004 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459